

Appln No. 10/591,516
Amdt date October 25, 2011
Reply to Office action of July 25, 2011

REMARKS/ARGUMENTS

Applicant has amended each of claims 1-4 to substantially incorporate the features of cancelled claim 5. Each of claims 1-4 now recite, in part, a resin pulley molded with a phenol resin molding material. The amendments are fully supported by the originally filed specification and claims, and no new matter has been added.

Initially, Applicant notes that the Japanese priority application, from which this Application depends, recently issued from the Japanese Patent Office as Japanese Patent number 4679062. A copy of the issued Japanese patent is enclosed for the Examiner's convenience. Applicant believes that the issued claims are substantially similar to those of the present Application as amended by this Amendment.

In the July 25, 2011 Office action, the Examiner rejected claims 1-5 under 35 the ground of nonstatutory obviousness-type double patenting over claims 1-8 of Asai et al. (U.S. 6,716,907) (Asai I) in view of Togashi et al. (U.S. 5,064,881) and Amagai et al. (U.S. 2003/0130438). In rejecting these claims, the Examiner admits that Asai I does not explicitly teach the use of silica having a particle size of 0.5 to 15 μm . Office action, pages 2 and 3. In addition, Asai I does not teach or suggest subjecting the silica powder to a coupling agent treatment as recited in the claims. The Examiner alleges, however, that it would have been obvious to combine Togashi (which allegedly teaches the claimed silica size) and Amagai (which allegedly teaches using a coupling agent surface treatment on silica) to arrive at the claimed invention. Office action, page 3. Specifically, the Examiner states that "[b]ased on the similarities in the compositions [of Togashi and Amagai], both including a phenol resin and glass fibers, it would be obvious" to combine the references with Asai I to "obtain good flowability and therefore good mold filling and reduced molding flaws, a reduced surface roughness, and a reduced mold shrinkage, which further results in reduced warping or misshaping of the molded article due to the shrinkage." Office action, page 4.

However, case law and MPEP § 2141.01(a) require that references used in a 35 U.S.C. § 103 rejection be analogous prior art. *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379-

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80 (Fed. Cir. 2007); *In re Kahn*, 441 F.3d 977, 986-87 (Fed. Cir. 2006); MPEP § 2141.01(a). To be analogous prior art, the reference "must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

In the present case, the "field of applicant's endeavor," as defined in the "technical field" section of the application is: "a phenol resin molding material used in automobile engine components and, more particularly, to a phenol resin molding material having improved abrasion resistance, especially improved resistance to dust of abrasion, and a resin pulley molded from said material." Neither Togashi nor Amagai are in Applicant's field of endeavor, as neither of Togashi nor Amagai are directed to phenol resin molding materials used in automobile engine components. Rather, Togashi is directed to a resin composition that "can be used as a sealing material for a semiconductor," while Amagai is directed to a curable resin composition "suitable for use in electronics fields requiring a low dielectric constant." Togashi, col. 1, lines 9-14; Amagai, paragraph 0001. The field of resin automobile engine components and resin sealants for semiconductors and resin for use in electronics are separate and distinct fields. As such, despite the fact that the present application and cited references both very generally relate to resins, neither of Togashi nor Amagai is in Applicant's field of endeavor.

Although not in Applicant's field of endeavor, Togashi and/or Amagai may nonetheless be analogous if they are reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446. The MPEP states that a reference is reasonably pertinent to a particular problem with which an inventor is concerned if it "logically would have commended itself" to the attention of a person having ordinary skill in the art trying to solve the problems addressed by Applicant. MPEP § 2141.01(a). The problem addressed by Applicant included providing molded resin automobile components having "improved abrasion resistance" while reducing the "large load [that] is applied to production facilities such as molds and molding machines." Specification, paragraphs 0001-0003. Togashi and Amagai are not reasonably pertinent to these particular problems. That is, Togashi was concerned with reducing the shrinkage of epoxy resin molding, and obtaining good flowability, thereby providing a resin

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with good moldability, reduced flaws, and reduced surface roughness. Togashi, col. 1, lines 9-14; col. 4, lines 32-50; and col. 7, lines 54-60. Amagai, on the other hand, was concerned with providing a resin for use in coating, bonding, and molding electronics, thus requiring various properties such as a low dielectric constant, a low dielectric loss tangent, and high fracture toughness. Amagai, paragraphs 0001, 0010, 0011. The problems addressed by Togashi and Amagai are problems related to electronics goods. Providing a molded resin product having, for example, low dielectric constant, was simply not a concern of the present inventors who were attempting to provide a molded resin component for automobiles that has improved abrasion resistance while reducing the large load to production facilities. As such, the problems of Togashi and Amagai, while generally related to the use of resins, are not related to the particular problem of improving resistance to dust abrasion while reducing the load applied to production facilities.

In summary, Togashi and Amagai are neither in the field of Applicant's endeavor nor reasonably pertinent to the problem addressed by Applicant, and therefore, Togashi and Amagai are non-analogous art. As the Examiner recognizes that Asai I fails to teach or suggest all features of independent claims 1-4, and as Togashi and Amagai are not analogous art, claims 1-4 are allowable over Asai I.


The Examiner also rejected claims 1-5 under 35 U.S.C. § 103(a) as obvious over Asai et al. (U.S. 2002/0123557) (Asai II) in view of Togashi and Amagai. The Examiner recognizes that Asai II fails to teach or suggest all features of claims 1-4. Office action, page 5. As stated above, Togashi and Amagai are not analogous art. As the Examiner recognizes that Asai II fails to teach or suggest all features of claims 1-4, and as Togashi and Amagai are not analogous art, claims 1-4 are allowable over Asai II.

Claims 1-4 now remain in this application. In light of the above amendments and remarks, Applicant submits that all of pending claims 1-4 are in condition for allowance. Applicant therefore respectfully requests a timely indication of allowance. However, if there are

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any remaining issues that can be addressed by telephone, Applicant invites the examiner to contact Applicant's counsel at the number indicated below.

Respectfully submitted,
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